

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIETMAR SWORA and JOCHEN SCHILBACH

Appeal No. 2000-0051
Application No. 08/545,629

HEARD: February 20, 2002

Before KRATZ, TIMM and DELMENDO, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 10-13, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method for making a hydroxyl group containing binder useful as part of a two

component organic lacquer coating agent. Claim 10, the sole independent claim on appeal, is reproduced below.

10. A process for producing a water-dilutable binder, having hydroxyl groups and after an addition of a liquid organic polyisocyanate component with free NCO-groups in an amount which corresponds to a proportion of NCO/OH of 0.8 : 1 to 3 : 1, which is ready to be used as an organic lacquer coating agent and which after being applied to a substrate hardens into a hard film due to crosslinking reactions, consisting essentially of the following steps:

a) concentrating a binder which consists of a non-water-soluble, carboxylate and sulfonate free polyester resin and/or polyacrylate resin with a content of hydroxyl groups of 2.5 to 8 % by weight OH and an organic solvent to a content of solids of 80 to 90 % by weight, the balance being the organic solvent to form a solvent-containing polyester and/or polyacrylate resin;

b) adding to the concentrate produced in step a) an emulsifier in an amount of 0.1 to 10 % by weight of the solvent-containing polyester and/or polyacrylate resin; and

c) subsequently to step b), blending water with the solvent-containing polyester and/or polyacrylate resin to create the water-dilutable binder as a storage-stable emulsion, capable of blending with the polyisocyanate component with free NCO groups prior to use.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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| Mallonee | 2,968,575 | Jan. 17, 1961 |
| Renk | 5,380,792 | Jan. 10, 1995 |

Claims 10-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Renk in view of Mallonee.

We refer to the briefs and to the answer for the opposing viewpoints expressed by appellants and by the examiner concerning the above-noted rejection.

OPINION

Upon careful review of the entire record including the respective positions advanced by appellants and the examiner, we find ourselves in agreement with appellants in so far as the examiner has failed to carry the burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, we will not sustain the examiner's rejection. Our reasoning follows.

We note that all of the claims on appeal require a method that includes the step of concentrating a binder that consists of a specified non-water-soluble, carboxylate and sulfonate free polyester resin and/or polyacrylate resin and an organic solvent to provide a solvent containing resin with a solids content of 80 to 90 weight percent, the step of adding an emulsifier to the

product of the latter step and subsequently the step of blending water therewith (claim 10, steps a-c).

The examiner acknowledges that Renk does not disclose the use of a solvent for a water dispersible or water soluble polyol. Consequently, Renk does not disclose appellants' concentrating step. According to the examiner (answer, page 3),

the use of solvents to dissolve such resins, as polyesters, prior to their emulsification, by means of external emulsifiers, within water was a known and conventional technique at the time of the invention. This position is supported by the teachings of Mallonee at column 2, lines 13-21; column 3, lines 6-53; and column 4, lines 23+.

Renk is directed to producing a two component coating composition, one of which components is a polyol containing component, which polyol component may be water soluble or dispersible in the presence of an emulsifier. Mallonee (column 1, lines 60-69 and column 2, lines 5-13) is concerned with chain extension of addition products of a stoichiometric excess of organic diisocyanate with organic high molecular weight compounds having terminal active hydrogens and forming stable lattices of the chain-extended products. Mallonee (column 2, lines 13-21, column 4, lines 26-31) teaches that when his addition product is too viscous, it can be diluted with an inert organic solvent. While the polyol of Renk (column 5, lines 1-45 and column 6, line

62 through column 7, line 24) may be pre-reacted with an isocyanate component, that prereaction is only conducted so long as hydroxy functionality is maintained.

As found by the examiner and noted above, Renk does not disclose using an organic solvent and a concentration step as herein claimed. Nor has the examiner fairly explained why the disparate teachings of Mallonee would have led one of ordinary skill in the art to modify the method of Renk so as to arrive at the claimed subject matter, including the above-noted limitations. "It is well established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion or motivation to lead an inventor to combine those references." Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). The examiner (answer, page 5) has only made general statements regarding non-readily emulsifiable materials behaving similarly and environmental and economic concerns as alleged advantages of using a solvent in the method of Renk based on the teachings of Mallonee without specifying why one of ordinary skill in the art would have been led by any particular disclosure of Mallonee to modify the particular method of Renk so as to arrive at the herein claimed subject matter

including the step of concentrating the mixture as recited in step a of claim 10. In this context, the examiner must provide specific reasons or suggestions for combining the teachings and disclosures of the applied secondary reference with Renk. In this context, the examiner's rejection falls short in not identifying a convincing and particularized suggestion, reason or motivation to combine the references or make the proposed modification in a manner so as to arrive at the claimed invention. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness in view of the reference evidence. Because we reverse on this basis, we need not reach the issue of the countervailing evidence discussed by appellants at page 13 of the brief. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

CONCLUSION

The decision of the examiner to reject claims 10-13 under 35 U.S.C. § 103 as being unpatentable over Renk in view of Mallonee is reversed.

REVERSED

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| PETER F. KRATZ |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CATHERINE TIMM |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| ROMULO H. DELMENDO |) | |
| Administrative Patent Judge |) | |

PFK/sld

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KARL F. ROSS
5676 RIVERDALE AVE
P.O. BOX 900
RIVERDALE BRONX, NY 10471-0900

APPEAL NO. - JUDGE KRATZ
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DECISION: **ED**

Prepared By:

DRAFT TYPED: 03 Jun 03

FINAL TYPED: